REMARKS

Claims 1-30 are pending in the present application. By this Response, claims 1-6, 9-11, 16, 17, 20, 21, 24-26 and 27 are amended, claims 12-14 are canceled, and claims 28-30 are added. Claims 1, 11, 16 and 26 are amended to recite "wherein selecting a transcoder from the set of transcoders includes using the set of characteristics to perform a lookup of a transcoder corresponding to one or more characteristics in the set of characteristics in a transcoder data structure having entries for a plurality of transcoders." Claims 6, 21 and 27 are amended to recite "wherein selecting a transcoder from the set of transcoders includes using the identification information for the client originating the request to perform a lookup of a transcoder corresponding to the identification information for the client originating the request in a transcoder data structure having entries for a plurality of transcoders." These features are supported by the present specification at least on page 10, line 24 to page 11, line 15.

Claims 2 and 9 are amended to recite "wherein the set of transcoders includes one or more specific transcoders and one or more generic transcoders, and wherein if none of the one or more specific transcoders are a best match to the set of characteristics, a generic transcoder is selected." Claims 17 and 24 are amended to recite "wherein the set of transcoders includes one or more specific transcoders and one or more generic transcoders, and wherein if none of the one or more specific transcoders are a best match to the identification information for the client originating the request, a generic transcoder is selected." These features are supported by the present specification at least on page 10, lines 9-22.

Claims 3 and 4 are amended to place them in independent form. Claims 5 and 10 are amended to recite "wherein the set of characteristics includes an application characteristic identifying an application on the client that is to receive the content and a device characteristic identifying a type of device that the client is, and wherein selecting a transcoder includes: attempting to find a best match transcoder in the transcoder data structure based on the application characteristic; and if a best match transcoder is not found based on the application characteristic, attempting to find a best match transcoder

in the transcoder data structure based on the device characteristic." Support for these features may be found at least at page 13, lines 16-23 of the present specification.

Claims 10 and 25 are amended to recite "wherein the identification information for the client originating the request includes information identifying an application on the client that is to receive the content and information identifying a type of device that the client is, and wherein selecting a transcoder includes: attempting to find a best match transcoder in the transcoder data structure based on the identifying the application; and if a best match transcoder is not found based on the information identifying the application, attempting to find a best match transcoder in the transcoder data structure based on the information identifying the type of device." Support for these features may be found at least at page 13, lines 16-23 of the present specification.

Claims 28 and 30 are added to recite "wherein the set of characteristics includes a user characteristic identifying a particular user of the client, and wherein the user characteristic is used to select a transcoder that meets output preferences of the user." Claims 29 and 31 are added to recite "wherein the output preferences of the user include one or more of particular color preferences, screen layout preferences, and sound output preferences." These features are supported on page 11, line 25 to page 12, line 5 of the current specification.

No new matter is added as a result of the above amendments. Reconsideration of the claims in view of the above amendments and the following Remarks is respectfully requested.

I.   <u>35 U.S.C. § 102(e), Alleged Anticipation, Claims 1, 2, 5, 6, 9-17, 20, 21, 24-27</u>

The Office Action rejects claims 1, 2, 5, 6, 9-17, 20, 21 and 24-27 under 35 U.S.C. § 102(e) as being anticipated by Dutta et al. (U.S. Patent No. 6,615,212). This rejection is respectfully traversed.

> As to claims 1, 6, 16, 21, 26, and 27, the Office Action states:
> As to claims 1, 6, 16, 21, 26 and 27, Dutta et al discloses a dynamically provided content processor for transcoding data types at intermediate stages of transcoding process that teaches:
> > - Receiving a request for content from a client, wherein the

request includes a set of characteristics or identification
information (column 5, line 66-column 5).
- Selecting a transcoder from a set of transcoders having a best
match to the set of characteristics, or identification information,
and transcoding, or processing, the content using the transcoder to
form transcoded content (column 7, line 63-column 8, line 11)
Office Action dated December 3, 2003, page 2.

Amended independent claim 1, which is representative of independent
claims 6, 11, 16, 21, 26 and 27 with regard to similarly recited subject matter,
reads as follows:

> 1.   A method in a data processing system for transcoding content using a set
> of transcoders, the method comprising:
>   receiving a request for the content from a client, wherein the request
> includes a set of characteristics;
>   selecting a transcoder from the set of transcoders having a best match to
> the set of characteristics, wherein selecting a transcoder from the set of
> transcoders includes using the set of characteristics to perform a lookup of a
> transcoder corresponding to one or more characteristics in the set of
> characteristics in a transcoder data structure having entries for a plurality of
> transcoders; and
>   transcoding the content using the transcoder to form transcoded
> content.
> (emphasis added)

Dutta is directed to a method for providing content from a distributed database to
a client. A transcoding proxy server receives a request for content from a client machine.
The transcoding proxy server retrieves the content from an originating server. The
retrieved content is provided in a first format type. In response to a determination that an
increase in efficiency would be obtained by allowing the client to process the content in
the first format type prior to transcoding the content into a second format type, the
transcoding proxy server sends content processing software for processing the content in
the first format, the transcoding proxy server sends content processing software for the
first format type along with the content in the first format type to the client. The
transcoding proxy server then transcodes the content from the first format type into the
second format type and sends the content in the second format to the client (Abstract).

Thus, Dutta teaches a transcoding proxy server that first determines the efficiency
of a client by determining the estimated amount of time it takes to transcode the content

from the first format type provided by the originating server to a second format type requested by the client. If the transcoding proxy server determines that the efficiency will increase by sending the content processing software together with the transcoding content in a first format type to a client, the transcoding proxy server sends the content processing software and the content in the first format type to the client, while transcoding the content into a second format type. The client may start analyzing the content using the content processing software and the first format type content while waiting for the second format type content to be transcoded. As a result, the processing time needed to process the requested content is reduced.

However, Dutta does not teach selecting a transcoder from the set of transcoders having a best match to a set of characteristics received in a request, wherein selecting a transcoder from the set of transcoders includes using the set of characteristics to perform a lookup of a transcoder corresponding to one or more characteristics in the set of characteristics in a transcoder data structure having entries for a plurality of transcoders, as recited in claim 1. In fact, Dutta does not teach any particular mechanism for selecting transcoders, let alone selecting a transcoder from a plurality of transcoders. To the contrary, the examples provided in Dutta as to how the system operates implies that the same series of transcoders will be used with each transaction, its just that the series of transcoders used may be cut short if the client has its own ability to convert from an intermediate format to a request format.

For example, in column 7, line 63 to column 8, line 22 two example operations of the Dutta system are provided. In the first example, the transcoding proxy server has a BMP to PNG format converter and a PNG to GIF format converter. The client requests content in a GIF format and thus, the content is downloaded from the server in a BMP format and is converted to a PNG format using the BMP to PNG converter. The PNG formatted content is then converted to a GIF format using the PNG to GIF format converter and then sent to the client.

In the second example, the client has a PNG to GIF converter and thus, can receive the content in PNG format, rather than the requested GIF format, and then perform the conversion itself. As a result, the transcoding proxy server downloads the content from the server in BMP format and converts it to PNG format using the BMP to

Page 12 of 17
Hild et al. – 09/680,792

PNG converter. The content is then sent to the client device in PNG format. While the transcoding proxy server attempts to convert the PNG formatted content to a GIF format, the PNG formatted content that is sent to the client is converted to GIF format using the local PNG to GIF converter, which is faster than the PNG to GIF converter of the transcoding proxy server. As a result, the PNG to GIF converter at the transcoding proxy server is cut short and the client drops the connection.

Thus, in either situation, the same series of converters are utilized. There is no teaching or suggestion in Dutta to perform a selection operation which entails looking up an appropriate transcoder in a data structure having entries for a plurality of transcoders, based on a set of characteristics submitted in a request. Dutta is not concerned with selection of transcoders, but instead is focused on determining timing information for transcoding and based on this timing information, either sending an intermediate form of the content to the client along with processing software, or performing the entire transcoding of the content from an initial format to a requested format. Whether or not a particular transcoder from a plurality of transcoders is a best match for performing the transcoding, as determined from a set of characteristics submitted in a request for content, is not a concern in Dutta.

In view of the above, Applicants respectfully submit that Dutta does not teach each and every feature of claim 1 as is required under 35 U.S.C. § 102(e). In particular Dutta does not teach selecting a transcoder from a set of transcoders having a best match to the set of characteristics, wherein selecting a transcoder from the set of transcoders includes using the set of characteristics to perform a lookup of a transcoder corresponding to one or more characteristics in the set of characteristics in a transcoder data structure having entries for a plurality of transcoders. Independent claims 6, 11, 16, 21, 26 and 27 recite similar features to that of claim 1 and thus, distinguish over Dutta for similar reasons. At least by virtue of their dependency on claims 1, 6, 11, 16 and 21 respectively, Dutta does not teach or suggest the features of claims 2, 5, 9-10, 12-15, 17, 20 and 24-25. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 5, 6, 9-17, 20, 21 and 24-27 under 35 U.S.C. § 102(e).

In addition, Dutta does not teach the specific features of dependent claims 2, 5, 9-10, 12-15, 17, 20 and 24-25. For example, with regard to dependent claim 2, which is representative of claims 9, 17 and 24, Dutta does not teach a set of transcoders that includes one or more specific transcoders and one or more generic transcoders, wherein if none of the one or more specific transcoders are a best match to the set of characteristics, a generic transcoder is selected. Dutta, at most, only teaches the use of generic transcoders and does not teach anything regarding selecting such generic transcoders, let alone selecting a generic transcoder after a determination that none of the specific transcoders are a best match. As set forth in the present specification at page 3, lines 12-15, a generic transcoder is used to convert various server-generated content types into the client supported content types. Also set forth in the present specification at page 3, lines 24-27, a specific transcoder is a transcoder developed for different types of applications, devices, or different individual users. Dutta does not teach specific transcoders and furthermore, does not teach selecting a generic transcoder when it is determined that none of the specific transcoders are a best match. Thus, Dutta does not teach the specific features of claims 2, 9, 17 and 24.

With regard to claim 4, which is representative of claims 8, 19 and 22 with regard to similarly recited subject matter, Dutta does not teach a set of characteristics that includes a tuple including parameters for a document type definition, an application, a device, and a user. Dutta teaches only teaches that the desired type of format for the content sent in the request, e.g., GIF, PNG, etc., is used in transcoding the content. Dutta does teach that client device may be queried to obtain client device capability information in order to determine whether an intermediate form of the transcoded content can be sent to the client along with processing software, but there is no teaching or suggest in Dutta regarding a tuple that includes a document type definition, an application, a device, and a user. Thus, Dutta does not teach the specific features of claims 4, 8, 19 and 22.

With regard to claim 5, which is representative of claims 10, 20 and 25 with regard to similarly recited subject matter, Dutta does not teach or suggest a set of

characteristics that includes an application characteristic identifying an application on the client that is to receive the content and a device characteristic identifying a type of device that the client is, attempting to find a best match transcoder in the transcoder data structure based on the application characteristic, or if a best match transcoder is not found based on the application characteristic, attempting to find a best match transcoder in the transcoder data structure based on the device characteristic.

While Dutta teaches a request for content that includes a designation of the desired format of the content, Dutta does not teach anything about an application characteristic, which identifies an application that is to receive the content, or a device characteristic, which identifies the type of device that the client is. Dutta does teach that the client device may be queried to determine the client's software resources, i.e. whether a particular viewer or format converter is present on the client, but this does not designate the type of device that the client is. Furthermore, this information does not designate the application that is to receive the content.

Since Dutta does not teach an application characteristic or a device characteristic, Dutta cannot teach attempting to find a best match transcoder in the transcoder data structure based on the application characteristic. Furthermore, Dutta cannot teach that, if a best match transcoder is not found based on the application characteristic, an attempt is made to find a best match transcoder in the transcoder data structure based on the device characteristic.

In view of the above, Dutta does not teach the specific features of claims 2, 5, 9-10, 12-15, 17, 20 and 24-25 in addition to their dependency on independent claims 1, 6, 11 and 21, respectively. Accordingly, the Applicants respectfully request the withdrawal of the rejection of claims 2, 5, 9-10, 12-15, 17, 20 and 24-25 under 35 U.S.C. § 102(e).

II.   <u>35 U.S.C. § 103(a), Alleged Obviousness, Claims 3, 4, 7, 8, 18, 19, 22 and 23</u>

The Office Action rejects claims 3, 4, 7, 8, 18, 19, 22 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Dutta et al. (U.S. Patent No. 6,615,212), in view of

Musciano et al. ("HTML – The Definitive Guide")[1]. This rejection is respectfully traversed.

Applicants respectfully submit that the rejections of claims 3, 4, 7, 8, 18, 19, 22 and 23 under 35 U.S.C. § 103(a) are improper under 35 U.S.C. § 103(c). According to chapter 706.02(I)(1) of the MPEP, titled "Rejections Under 35 U.S.C 102(e)/103; 35 U.S.C. 103(c) [R-1]", under 35 U.S.C. § 103(c), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999.

The present invention was filed on October 6, 2000, which is dated after November 29, 1999. In addition, the present invention and the Dutta reference were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to the same entity, i.e. International Business Machine Corporation of Armonk, NY. Therefore, Dutta is disqualified as prior art under 35 U.S.C. § 103 against the claimed invention. In view of the above, Applicants respectfully request withdrawal of the rejections to claims 3, 4, 7, 8, 18, 19, 22 and 23 under 35 U.S.C. § 103(a)

III.   Newly Added Claims, Claims 28-30

With regard to newly added claim 28, which is representative of claim 30 with regard to similarly recited subject matter, Dutta does not teach a set of characteristics that includes a user characteristic identifying a particular user of the client, or using the user characteristic to select a transcoder that meets output preferences of the user. As described above, Dutta only teaches a request for content sent from a client to the transcoding proxy server that includes a designation of the desired format of the content. Dutta does not teach a user characteristic that identifies a particular user of the client.

---

[1] It is noted that the Examiner has not established the date of the Musciano reference and thus, has not established Musciano as prior art. However, based on Applicants' own research on the publisher's Web site, it has been determined that the date of the reference is August, 1998.

Page 16 of 17
Hild et al. – 09/680,792

Nowhere in the reference does Dutta teach or suggest a way to identify a particular user of the client. In addition, nowhere in the reference does Dutta teach or suggest using this user characteristic to select a transcoder that meets output preferences of the user.

With regard to newly added claim 29, Dutta does not teach output preferences of the user that includes one or more of particular color preferences, screen layout preferences, and sound output preferences. While Dutta teaches receiving a request from a client for content that includes a desired format of the requested content, Dutta does not a user characteristic that identifies output preferences of a user that include particular color preferences, screen layout preferences, or sound output preferences for a user. Nowhere in the reference does Dutta teach or even suggest a user characteristic that identifies particular color preferences, screen layout preferences, or sound output preferences of a user of the client system. Thus, Dutta does not teach each and every feature of newly added claims 29-30.

IV.   Conclusion

It is respectfully urged that the subject application is patentable over Dutta and Musciano and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: March 3, 2004
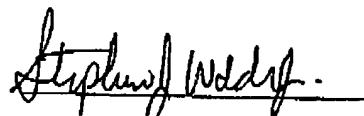
Stephen J. Walder, Jr.
Reg. No. 41,534
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001
Attorney for Applicants

SJW/im

Page 17 of 17
Hild et al. – 09/680,792